

Remarks

Applicants reply, after entry of the RCE, to the Advisory Action dated January 12, 2012 and the Final Office Action dated November 18, 2011. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter is entered with these amendments. Applicants respectfully request reconsideration of this application.

Rejection under 35 U.S.C. § 112

Applicants thank the Examiner for thoughtful and thorough Advisory Action detailing the Examiner's position. By way of review, in the Final Office Action, the Examiner rejected claims 1-7, 9-20 under 35 U.S.C. 112 first paragraph, as failing to comply with the written description requirement. Applicants respectfully disagree with these rejections, but Applicants present claim amendments in order to clarify the patentable aspects of the claims and to expedite prosecution.

Specifically, the Examiner states that the limitation "limiting, by the computer based system, access to the primary message to the first intended recipient to a pre-selected period after which the primary message is not accessible to the first in[t]ended recipient; and maintaining, by the computer based system, the primary message in the common storage area of the database for dynamic access by a second intended recipient via the secure website, wherein the primary message may be accessible to the second intended recipient after the pre-selected period".... "was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

"The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the

artisan that the inventor had possession at that time of the later claimed subject matter.’ *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. “Prior to determining whether the disclosure satisfies the written description requirement for the claimed subject matter, the examiner should review the claims and the entire specification, including the specific embodiments, figures, and sequence listings, to understand how applicant provides support for the various features of the claimed invention.” (See MPEP 2163 2., emphasis added) Applicants maintain that the entire specification including the specific embodiments provide support for the various features of the claims.

Applicants respectfully submit that one of ordinary skill in the art would reasonably conclude that Inventors were in the “possession of the invention” at the time of filing.

- The limitation “limiting, by the computer based system, access to the primary message to the first intended recipient to a pre-selected period after which the primary message is not accessible to the first intended recipient” is at least supported by Paragraph [0020] which states: “After a user reads a message, the message is flagged in the database as being read by that user. A set time period can be set for the message to remain accessible to the user.”
- The limitation “maintaining, by the computer based system, the primary message in the common storage area of the database for dynamic access by a second intended recipient via the secure website” is at least supported by Paragraph [0024] “In another embodiment of the invention, a save feature is available to the user. Using the save feature, the expiration date of the message is extended by a period of time established by the user or a default by the system. Such functionality may be provided by changing the expiration date field in the message database, (emphasis added).

Those of ordinary skill in the art upon reading this application would understand that such application at least implies such disclosure of “limiting, by the computer based system, access to the primary message to the first intended recipient to a pre-selected period after which the

primary message is not accessible to the first in[t]ended recipient; and—maintaining, by the computer based system, the primary message in the common storage area of the database for dynamic access by a second intended recipient via the secure website.”

Moreover, paragraph [0033] of the instant application recites “In the foregoing specification, the invention has been described with reference to specific embodiments. However, it will be appreciated that various modifications and changes can be made without departing from the scope of the present invention. The specification and figures are to be regarded in an illustrative manner, rather than a restrictive one, and all such modifications are intended to be included within the scope of present invention.” (emphasis added)

Thus, Applicant respectfully asserts the present application adequately describes the claimed invention. Applicant respectfully requests favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 112.

Moreover, the Examiner states “it makes no sense to combine the features of these two embodiments as applicant has attempted to claim as a elimination of a message from a database after an expiry date for a first user (as discussed in paragraph 20) would necessarily cause a second user (if one exists) to also not be able to access that message as that message no longer exists in the database for the second user to access.”

In the Advisory Action, the Examiner states on pages 4 and 5 “A second user cannot possibly access something that no longer exists. To make an analogy, think of the message as a shared pie that can be eaten by multiple people. Once that pie is gone (because it got totally eaten or disposed in the trash) so that a first person cannot eat it, one cannot logically say that it is still available to be eaten by someone else as that pie no longer exists for such a purpose.”

Note paragraph 20 states “After a user reads a message, the message is flagged in the database as being read by that user” (emphasis added). Also, note the phrase “that user” suggests the message may be available to more than one user. Please note that paragraph 21 states the “expiration date of the message is extended by a period of time established by the user or a default by the system.” For instance, in one embodiment, the expiration date of the message may be extended by a period of time until all users have read the message. Once all users have read the message and the message may be removed from the database thereby eventually creating faster performance once the message is removed. The specification does not mandate that the expiration date be immediate as the Office Action appears to purport. The specification suggests

that it may be removed after being flagged by all users. "Though understanding the claim language may be aided by explanations contained in the written description, **it is important not to import into a claim limitations that are not part of the claim**" (emphasis added). (See MPEP 2111.01).

The Examiner appears to be reading limitations regarding deletion of the message from the specification into the claim. Paragraph [0020] which states "A set time period can be set for the message to remain accessible to the user or the system can limit the number of times the message may be accessed. After such time, the user would be unable to access the message. Such functionality can be provided in a variety of manners." This excerpt does not discuss deletion of the message and supports the limitations as claims.

For at least the reasons above, Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness. As such, Applicants respectfully assert the rejection should be reconsidered and withdrawn.

When a phrase similar to "at least one of A, B, or C" or "at least one of A, B, and C" is used in the claims or specification, Applicant intends the phrase to mean any of the following: (1) at least one of A; (2) at least one of B; (3) at least one of C; (4) at least one of A and at least one of B; (5) at least one of B and at least one of C; (6) at least one of A and at least one of C; or (7) at least one of A, at least one of B, and at least one of C.

Applicant respectfully submits that the pending claims are in condition for allowance. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **19-2814**. Applicant invites the Examiner to telephone the undersigned, if the Examiner has any questions regarding this Reply or the present application in general.

Respectfully submitted,

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By: 
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